

Remarks

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

Thus, each of claims 4 and 8, which are the only independent claims under consideration, has been amended to recite that the water-based heat-radiation-preventive coating material for glasses is one "consisting essentially of" the recited components, the significance of which will be apparent from remarks set forth below. In view of these amendments, claims 22 and 24, which are dependent on claims 4 and 8, respectively, have been amended to replace the "comprises" language with "consists essentially of" language, in order to conform to the wording of amended claims 4 and 8.

Applicant respectfully submits that the foregoing amendments should be entered even though they are being presented after final rejection, since the effect of the amendments is to clearly avoid the rejection of the claims under the first paragraph of 35 U.S.C. §112, and as will be apparent from the remarks set forth below, these amendments also avoid the rejection of the claims under 35 U.S.C. §103(a).

In connection with the rejection of claims 4, 7, 8, 10 and 21-25 under the first paragraph of 35 U.S.C. §112, the Examiner takes the position that the limitation that the coating material is free of inorganic metal oxide is considered to be new matter, i.e. is not described in the specification. This rejection has been rendered moot in view of the claim amendments, deleting this language.

The patentability of the presently claimed invention over the disclosure of the reference relied upon by the Examiner in rejecting the claims will be apparent upon consideration of the following remarks.

Thus, the rejection of claims 4, 7, 8, 10 and 21 under 35 U.S.C. §103(a) as being unpatentable over Havey et al. (US '163) is respectfully traversed.

As apparent from this reference, for example its abstract and claim 1, the coating compositions of Havey et al. must contain a tetrafunctional silane as an essential component; and the Examiner makes reference to this tetrafunctional silane in discussing the reference disclosure. Applicant notes that in Havey et al. since a tetrafunctional silane is an essential component, it is necessary to use an aqueous organic solvent such as low alcohol in order to control hydrolysis.

On the other hand, the present invention does not use a tetrafunctional silane, and in fact, this component is excluded from the coating material of the presently claimed invention in view of the "consisting essentially of" language now incorporated into the present claims.

In this regard, as the Examiner knows, the expression "consisting essentially of" excludes from the coating material any substance that would materially affect the basic nature or characteristics of the invention. In this connection, please see Experiments [2]-1 to [2]-3 in the attached Declaration under 37 CFR 1.132 by an employee of the current Assignee of the present application, showing that a uniform solution cannot be obtained when a tetrafunctional silane is blended in a water-based solution, and thus a coating film cannot be formed.

Thus, it is clear that a tetrafunctional silane would materially affect the basic nature or characteristics of the present invention, and therefore, is excluded by the "consisting essentially of" language in the claims.

For these reasons, Applicant takes the position that the presently claimed invention is clearly patentable over the applied reference.

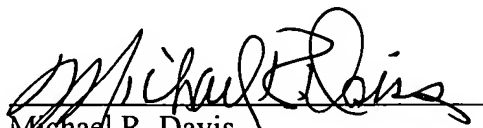
Applicant notes that the attached Declaration also includes Experiment [1] concerning the previously applied Scholz et al. reference. This experiment shows that if the coating material contained a porous inorganic metal oxide, as required by Scholz et al., this would materially affect the basic nature or characteristics of the present invention, since a coating composition containing a porous inorganic metal oxide does not exhibit heat-radiation-preventive effect.

Therefore, in view of the foregoing amendments and remarks, it is submitted that each of the grounds of rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

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